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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,499	05/18/2001	Masahiro Nishio	862.C2228	5043

5514 7590 10/05/2004

FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/859,499	<b>Applicant(s)</b> NISHIO, MASAHIRO	
	<b>Examiner</b> Yves Dalencourt	<b>Art Unit</b> 2157	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 and 21-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is responsive to communication filed on 05/18/01.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1 – 16, and 20, drawn to a network device connected to a network and having a plurality of controllers, classified in class 709, subclass 201.

Group II. Claims 17 – 19, 21 - 35, drawn to a network controller connected to a peripheral device and to a communication line, classified in class 709, subclass 250.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the step of discriminating the received data, which is to be processed by a peripheral device is not needed in a network device connected to a network in order to allow messages to be exchanged between the agents. The subcombination has separate utility such as in a network for configuring peripheral processing device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Leonard Diana on 09/16/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 – 16, and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 – 19, and 21 – 35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Therefore, " Disclosed " (line 1); " means " (lines 6 and 7) in the abstract, are implied and should be avoided.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 5, 8, 10, 11, 13, 14, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 3, 5, 8, 10, 11, 13, 14, and 16, the limitation of " means for notifying subagents of the second message " is not enabled in the specification. It has not been described how the subagents or other subagents are been notified of the second message. Therefore, one skilled in the art would not know how to make and/or use the invention.

Claims 4, 9, 12, 15, and 20 are necessarily rejected as being dependent upon the rejection of claims 3, 5, 8, 10, 11, 13, and 14.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 5, 8, 10, 11, 13, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, 5, 8, 10, 11, 13, 14, and 16, the limitation of “means for separating a message issued from a network manager into a first message containing management information to be processed by the master agent and a second message containing management information other than said management information to be processed “ is unclear. Is the second message containing management information other than said management information is to be processed by the subagent?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 2 and 6 - 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Fletcher et al (US 6,108,782; hereinafter Fletcher).

Regarding claims 1 and 6, Fletcher teaches a network device and method connected to a network and having a plurality of controllers (fig. 1), which comprises a plurality of databases (60, 61a, 61b, 62, and 65a; fig. 1; Fletcher discloses dRMON collectors) disposed in distributed fashion on respective ones of the plurality of controllers and storing management information relating to respective ones of the controllers (col. 6, lines 10 – 16; col. 8, lines 46 - 63; Fletcher discloses dRMON agents, which are software or software plus hardware components, are placed within each of the ESs connected to the LAN or within server machines); and a plurality of agents distributed on the plurality of controllers (50a-c, 51a-c, 52a-g; fig. 1; paragraph bridging col. 1, line 54 through col. 2, line 9); wherein each of the plurality of agents has means for communicating with one another (col. 13, lines , 46 – 56; col. 14, lines 20 – 25), means for executing distributed processing of messages issued from a network manager (col. 11, lines 25 – 33), and means for generating responses to these messages (col. 6, lines 40 – 46; col. 9, lines 33 – 43; col. 18, lines 1 - 9).

Regarding claims 2 and 7, Fletcher teaches a network device and method, wherein at least one agent among the plurality thereof functions as a master agent and the other agents function as subagents (col.10, lines 10 – 27; Fletcher discloses an extensible SNMP agent that provides the UDP/IP protocol stack, PDU parser and basic MIB-II support); and each of said agents communicates with one another using a network manager that manages the network, and a protocol for management information exchange between the network manager and said network device (col. 13, lines , 46 – 56; col. 14, lines 20 – 25).



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hunt et al (US Patent Number 6,539,422) discloses an automatic data collection device having a network communications capability.

Raz et al (US Patent Number 6,529,515) discloses a method and apparatus for efficient network management using an active network mechanism.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (703) 308-8547. The examiner can normally be reached on M-TH 7:30AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

Y. D

September 27, 2004

  
ARJO ETIENNE  
SUPERVISORY PATENT EXAMINER  
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